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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/486,643	06/07/95	HARTIG	K 2372.853

EXAMINER
SPEER, T

ART UNIT	PAPER NUMBER
D3M1/1003	6

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DATE MAILED: 10/03/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on 07-23-96

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☐ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) 14-31 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

– SEE OFFICE ACTION ON THE FOLLOWING PAGES –

1.

Applicant's election with traverse of Group I in Paper No. 5 (07-23-96) is acknowledged. The traversal is on the ground(s) that the inventions are related and should be examined together. This is not found persuasive because the Examiner, in Paper No. 4, demonstrated that the inventions of Groups I and II are properly restricted and applicant has failed to show otherwise.

The requirement is still deemed proper and is therefore made FINAL.

2.

The Information Disclosure Statement (IDS) filed on 06-07-95 has been considered and made of record. A copy of the IDS initialed and dated by the Examiner is included herewith.

3.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4.

Claims 1 and 8-11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 8-11 of copending Application No. 08/102,281. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6.

Claims 2-7, 12 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-7, 12 and 13 of copending Application No. 08/102,281. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the instant claims and those of 08/102,281 is the definition of the term "chemically resistant." In the present specification, chemical resistance defines articles having no pinholes of greater than about 0.003", while in the copending application this value is 0.015". Since the subject matter of the present application overlaps that claimed in the copending application, issuance of the instant claims would unfairly extend applicant's right to exclude granted if the copending application issues. Additionally, reducing the size of pinholes in the article would have been obvious to one having ordinary skill in the art in order to provide a more durable article.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7.

Any inquiry concerning this communication should be directed to Timothy M. Speer at telephone number (703) 308-3624.

Timothy M. Speer
Patent Examiner
Group 1300

T.M. Speer/ts
September 29, 1996